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EXAMINER
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 10

Application Number: 09/451,315
Filing Date: November 30, 1999
Appellant(s): MCINTYRE ET AL.

Frank Pincelli
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/28/2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-33 have been rejected and are appealed. (Claim 34 was canceled previously).

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 3-9, 11-16 do not stand or fall together with claims 2, 10, 17-34 and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,791,991	***SMALL***	***9-1998***
6,203,427	***WALKER et al***	***3-2001***
6,336,099	***BARNETT et al***	***1-2002***
5,679,075	***FORREST et al***	***10-1997***

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. **Claims 1, 7, 8, 12 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Small (US 5791991).**

Regarding claims 1, 12, 16, Small teaches software for a consumer product promotion and game system where images are incorporated into a matching game. The computer program that runs the game and the images used in the game are stored on a remote storage medium and when the program is loaded into client memory and run by the client, the images are "located and selected" so that the game can be played by the consumer client PC client [col 2 line 59 to col 3 line 21]. The images are taken to be "supplied" to the client PC "by the user," as it is the user that requests/downloads/supplies the images to the client PC from the remote storage medium, by way of selecting and loading/playing the game. In this manner, at least one image is taken to be "supplied by a user" to the client PC. Participation in the game or winning the game results in automatic display of a message(s) [col 7 lines 26-58].

Regarding claims 7, 8, a product coupon is sent by the system to the user PC for printing [col 7 lines 51-58].

Regarding claims 14 and 15, the Bingo game described by Small is taken to be a square section puzzle.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 2, 10, 11, 13, (14, 15 alternatively), 17, 22, 23, 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small.**

Regarding claims 2, 10, 17, 22, 23, 25, 27, 31-34, Small teaches interaction between the user and remote computers via web sites over the Internet, including providing hot links to web sites of participating manufacturers [col 5 lines 14-27]. Small also teaches prompting the user to select products or product categories and sending the requested data such as rebate data to the user. Small also suggests manufacturers sponsoring games and displaying ads for the user [col 9 lines 3-6]. Small also teaches providing the user with product-related information at the conclusion of the games [col 7 lines 51-57]. It would have been obvious to one of ordinary skill at the time of the invention to have accomplished such requested promotional/advertising information delivery by way of the hot links mentioned by Small at the conclusion of games, so that users can easily request and obtain such rebate information and can select/click to learn more about various products and browse the promoting manufacturer's web site(s). A feature including links to manufacturer and product information pages is taken to enable "automatic forwarding" a user to a remote computer site upon completion of the game.

Regarding claim 11, 26, the program and images required by the system of Small are inherently stored on some type of accessible media. It would have been obvious to one of ordinary skill at the time of the invention to have stored such on a hard drive computer disk for speedy access and retrieval of the data.

Regarding claims 13-15, 28-30, Small provides a matching game with images covering "hidden" tiles. The computer randomly selects product groups and checks to see if the user's selected hidden tiles match. If so, the hidden tiles are revealed. The computer uses images or a mosaic of images to provide the covering tile texture/surfaces. The game is Bingo, not concentration. However, Small teaches that other match games can be used instead [col 9 lines 12-15]. Official Notice is taken that the instantly described game of Concentration is a known game, where pairs of hidden cards/tiles are selected for matches to be revealed. It would have been obvious to one of ordinary skill at the time of the invention to have provided the promotional aspects of Small using the known game of Concentration rather than Bingo in order to provide a different game experience. Small provides a square section game/puzzle and it would have been obvious to one of ordinary skill at the time of the invention to have to have provided the known Concentration matrix as one which is square.

5. **Claims 3-6 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small in view of Walker et al (US6203427).** Walker et al also teaches computer games. Each game/contest includes a gameID, customerID and winning information. The winning information is also encrypted [fig 11b, col 9 lines 1-25]. It would have been obvious to one of ordinary skill at the time of the invention to have

provided such game/contest identification means so that a winner requesting the prize must verify the authenticity of the winning contest by any well known means such as by phone or computer, so as to eliminate fraudulent collection of prizes. It would have been obvious to one of ordinary skill at the time of the invention to have encrypted the contest and winning information to further secure against fraud.

6. **Claims 9 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small in view of Barnett et al (US6336099).** Small does not take steps to prevent a user from printing multiple copies of coupons. Barnett et al also teaches electronic coupon distribution, but takes steps to ensure coupons can only be printed once [col 5 lines 47-62]. It would have been obvious to one of ordinary skill at the time of the invention to have prevented users from printing awarded coupons more than once, so as to eliminate fraud and to encourage playing multiple games, thus being subjected to more sponsorship promotion.

7. **Claim 11 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Small in view of Forrest et al (US5679075).** Forrest et al also teaches computer puzzle games. Forrest et al teaches that such puzzle games can be provided by a remote computer over the Internet, or alternately on CD ROMs distributed to playing users. It would have been obvious to one of ordinary skill at the time of the invention to have provided Small's promotional gaming on distributed CD ROMS so that server resources can be reduced.

(11) Response to Argument

Applicant argues that the invention provides a game having images of particular relevance by including personal images supplied by the user. Applicant's claim language of "locating and selecting at least one digital image supplied by the user" is much broader than applicant's arguments. As stated above, a user requesting that a game program and included images be loaded from a server into a remote client PC's memory and subsequently played at the client PC accomplishes the broad "locating and selecting at least one image supplied by the user." The images are taken to be "supplied" to the client PC "by the user," as it is the user that requests/downloads/supplies the images to the client PC memory from the remote storage medium, by way of requesting and loading the game. During gameplay, the images are located and selected in order to be displayed and manipulated for purposes of visually playing the game. Applicant has not claimed a positive feature of a user authoring an image, nor is there any use of the term "***personal*** image" as argued. The "image supplied by a user" language requires no specified

recipient for the action of "supplying." The images are taken to be "supplied" to the client PC "by the user" as stated above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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jdc
June 17, 2003

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